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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,418

Applicant(s)

HARRIS ET AL.

Examiner

Shian T. Luong

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-25 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3728

***Election/Restrictions***

1. Claims 7-8 and 26-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rectangle and polygon central portion must be shown or the features canceled from claim 12. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The end caps and the central portions are frictionally coupled in claim 4 and not mechanically coupled. To be mechanically coupled, it has to have certain machinery or tools to perform the function. In the instant invention, the end caps in Figures 1, 6 and 7 are engaged by protrusion and recesses to frictionally engage. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20, 23, 28-29, 31, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook (US 3,750,871). Cook discloses two end caps 10,12 with recesses or cavities 16 configured in size and shape to receive therein the uppermost or lowermost portion or portions of contained item or items.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 9-10, 12-18, 20-23, 28-29, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US 2,274,196) in view of Cook (US 3,750,871). Gilbert discloses a transparent container 10 with two end caps 11. A merchandising card extends between the two caps. Although Gilbert does not show the card situated in the caps, Cook teaches two end caps 10,12 with recesses or cavities 16 configured in size and shape to receive therein the uppermost or lowermost portion or portions of contained item or items. The end caps stabilize the item and prevent unnecessary movement. The end caps also include flanges with

Art Unit: 3728

grooves 29, 31 to accept the tube. It would therefore been obvious in view of Cook to provide the recesses or cavities in the end caps to stabilize the card in Gilbert. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to make the tube out of thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

8. Claims 4-6 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 4, further in view of Jeffs et al. (US 5,711,446). Jeffs et al. Is only cited to show a typical tuber with recesses and protrusions to engage the respective protrusions and recesses on an end cap. The structural engagement is a typical type of coupling device well known in the container art.

9. Claims 11 and 19, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Official Notice. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Hence, whether or not the end caps are molded does not distinguish the final product of the container. With respect to claim 19, it would be obvious to provide indicia on the merchandise card of Gilbert to illustrate the content within the tube.

10. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook. It would also have been obvious to one having ordinary skill in the art at the time the invention was

Art Unit: 3728

made to make the tube out of transparent thermoplastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 20, further in view of Jeffs et al. (US 5,711,446). Jeffs et al. is only cited to show a typical tuber with recesses and protrusions to engage the respective protrusions and recesses on an end cap. The structural engagement is a typical type of coupling device well known in the container art.

12. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 20, further in view of Official Notice. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. Hence, whether or not the end caps are molded does not distinguish the final product of the container.

### ***Conclusion***

13. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information

Art Unit: 3728


without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579 or (703)305-3580. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on T-F from 7:00am to 4:00pm EST.

STL  
March 11, 2003

  
Primary Examiner  
Shian Luong  
Art Unit 3728